

2-2905 East Cliff Drive
Santa Cruz, CA 95062
Tel. (831) 462-8270
Fax: (831) 462-8273

Michael A. Guth
Attorney at Law

Fax

To: Nini Legesse

From: Michael A. Guth

Fax: 703 308-7768

Pages: 3

Phone: 703 605 1233

Date: 4/5/2004

Re:

CC:

☒ **Urgent**

☒ **For Review**

☐ **Please Comment**

☐ **Please Reply**

• **Comments:**

Please see attached

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Tiffin, Richard
 Assignee: The Tiffin Company, Inc.
 Title: Divot Practice Mat
 Serial No.: ~~10/371,874~~ 10/03 9,326 Filing Date: 02/20/03
 Examiner: Unknown Group Art Unit: 3711
 Docket No.: 1001-US

Santa Cruz, California
 April 5, 2004

COMMISSIONER FOR PATENTS
 Washington, D. C. 20231

INFORMAL SUBMISSION – PROPOSED AMENDMENT

The following comments are in regard to proposed amendments to be discussed with the Examiner on Wednesday, April 7, 2004. The goal of the Applicant is to find common ground with the Examiner to allow issuance of some claims. If this can be achieved, Applicant will either file a divisional to argue the currently rejected claims or transfer them to the previously filed CIP application. Applicant does ^{not} concede to any of the Examiner's arguments at this point except for this purpose.

Applicant's Attorney feels that by conceding many of the Examiner's points, solely for the sake of the goal stated above, there is allowable subject matter if just two of the Examiner's contentions are reviewed. The claim to be argued is claim 2. Claim 2 has both a 102 and a 103 rejection. A proposed amendment, with a supporting argument, is submitted below for the 102 rejection. This argument, if agreed upon, would render the 103 rejection of claim 2 moot.

102 argument – The Examiner has rejected claim 2 by tying the claimed element “mark retaining surface means ...” to item 112 of Perrine. Perrine's layer 112 in Figure 6, like its layer 12 in Figure 1, is not meant to be easily removed. It is disclosed as being attached by screws (Col. 5, ln 34) for the 12 and, for the 112, “a strip 150 ... may be thermally or adhesively bonded to the under surface of the top sheet 112”. In this disclosure, the top sheet 112, like the 12, is not disclosed as coming off of the base 114 after

assembly. And the strip 150 is bonded up into the top sheet; it appears to be permanently attached to the top sheet (note thermal bond reference, Col. 6, ln 55) which itself is not easily removeable. Nowhere does it disclose removal, (easy or otherwise) of the "mark retaining surface means", for example for later comparison to other such sheets.

The present invention, as seen in the figures, and as described on page 10, lines 21-23, allows for such removal and later comparison. Also the present application discloses the attachment of the "mark retaining surface means" using hook and loop fastening elements (Velcro), understood to be easily removable.

Thus, a further limitation that the "mark retaining surface means ..." is easily removable, such as "...wherein said mark retaining surface means is easily removed and replaced" would take claim 2 out of this rejection.

A second clear difference between Perrine and the present invention is that in Perrine the layer 150, used by the Examiner to illustrate the firm support layer, and the layer 112, used by the Examiner to illustrate the mark retaining surface means, are the same material/rigidity in Perrine, yet are disclosed as very different in the present invention (plastic or wood vs. paper, for example). Thus a limitation on the firm support layer such as "wherein said firm support layer is significantly more rigid than the mark retaining layer" is supported and removes claim 2 from the prior art rejection.

Applicant's Attorney feels that either of these changes would create an allowable claim. Applicant's Attorney looks forward to the Examiner's view and hopes that consensus can be reached.

Michael A. Guth
Attorney for Applicant
Reg. No. 45,983